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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,434	06/09/2000	Dean F. Jerding	A-6594	1996

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EXAMINER	
BELIVEAU, SCOTT E	

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/590,434	JERDING ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *96-104 and 109-117* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *96-104 and 109-117* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2004-06-02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 02 June 2004 was filed after the mailing date of the Non-Final Rejection on 22 April 2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Priority

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 96-104 and 109-117 of this application. In particular, the examiner cannot find support for the "receiving merchandise advertising data associated with a plurality of motion video presentations" and "receiving said one of the plurality of motion video presentations over the dedicated network session". The provisional application makes references to a similar architecture as that utilized by the instant application, however, there does not appear to be an enabling disclosure pertaining to the particular usage of such in conjunction with the delivery of merchandise advertising data as particularly claimed.

While the examiner has made every effort in reviewing the provisional application for support under 35 U.S.C. 112, given the size of the provisional application and lack of a clear correspondence between it and the instant application, information within the provisional application may have been overlooked. If the applicant continues to feel that the examiner has overlooked such support/subject matter, it is requested that the applicant reference this

subject matter by page number in response to this Office Action so that the examiner may quickly locate and evaluate the applicant's remarks in view of the provisional application.

Response to Arguments

3. Applicant's arguments with respect to claims 96 and 109 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 103 and 116 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filled, discloses the usage of an out-of-band tuner for bi-directional QPSK data communication and a QAM tuner for receiving television signals (IA: Page 6, Lines 14-16). Accordingly, it is unclear as to where support is found for the limitation wherein the "merchandise advertising data is carried via each of the first and second communication channels" corresponding to QAM and QPSK.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 96 and 109 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al. (US Pub No. 2003/0037068).

In consideration of claims 96 and 109, as illustrated in Figure 1, the Thomas et al. reference discloses a "set-top terminal (STT)" [40] coupled to a "server" [33/58] via a "bi-directional communication network" [42] for implementing the method as set forth. The "set-top terminal" [40] comprises a "memory having program code stored therein" [46] and at least "one processor that is programmed by the program code to enable the STT" [44] (Para. [0029] – [0032]). The system is operable to "receive user input corresponding to one of the plurality of motion video presentations", "establish a dedicated network session with the server for receiving said one of the plurality of motion video presentations", "receive said one of the plurality of motion video presentations over the dedicated network session" and to "provide said one of the plurality of motion video presentations to the user" in conjunction with the ordering and display of VOD programming (Para. [0065]). In conjunction with the control of the VOD programming, the system is operable to "suspend the provision of the motion video presentation responsive to a first user input" associated with either the "PAUSE" or "STOP" button and to further provide a "promotional motion video presentation to the STT responsive to the first user input" (Para. [0067] – [0069]). The "promotional

motion video presentation" may be that associated with previously "received merchandise advertising data" corresponding to one of a "plurality of motion video presentation" which is subsequently "provided . . . to a user via a television signal" for display during the pause state (Figure 2-3; Para. [0026]; [0040] – [0044]).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 96-103 and 109-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302).

In consideration of claims 96 and 109, as illustrated in conjunction with Figure 1, the White et al. reference discloses a "set-top terminal (STT)" [14] coupled to a "server" [12] via a "bi-directional communication network" [16] for implementing the method as claimed.

The "set-top terminal" [14] comprises a "memory having program code stored therein" [40/42] (Col 3, Lines 1-8) and at least "one processor that is programmed by the program code to enable the STT" [38] (Col 2, Lines 63-67). The terminal is subsequently operable to "receive merchandise advertising data" [72] associated with a "plurality of motion video presentation" and to "provide the merchandise advertising data to a user via a television signal" (Figure 4; Col 4, Lines 12-22). Subsequently, the system is operable to "receive user input corresponding to one of the plurality of motion video presentations" (Col 4, Lines 23-38), "establish a dedicated network session with the server for receiving said one of the plurality of motion video presentations", "receive said one of the plurality of motion video presentations over the dedicated network session" and to "provide said one of the plurality of motion video presentations to the user" (Col 4, Lines 38-64; Col 5, Lines 33-58). Furthermore, the system is operable to "suspend the provision of the motion video presentation responsive to a first user input" associated with either the "PAUSE" or "STOP" button and to further provide a "promotional . . . presentation to the STT responsive to the first user input" (Col 5, Lines 16-32).

With respect to the particular format of the promotion being a "motion video presentation", the reference does not particularly disclose nor preclude that the commercial or promotional message is necessarily static or dynamic in presentation. However, the reference suggests the HTML primitives utilized in presenting the display may be either still or moving (Col 10, Lines 21-24). The examiner takes OFFICIAL NOTICE the existence of commercial and/or promotion messages that comprise "motion video presentations" is common knowledge in the art that is capable of instant and unquestionable demonstration as

being well-known. For example, the existence of "promotional motion video presentations" including movie trailers for the exemplary movie "Ronin" [70] and/or the existence of animated or motion video advertisements for products such as the soft-drink Coke™ [72] are capable of instant and unquestionable demonstration as being well-known. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to utilize "motion video presentation" commercials or promotional messages for the inherent advantages associated with utilize motion versus static video promotions including an improved ability to draw a subscriber's attention to the promotion and/or commercial.

Claims 97 and 110 are rejected wherein the "merchandise advertising data comprises graphics" [72] (Figure 4).

Claims 98 and 111 are rejected wherein the "merchandise advertising data" [72] corresponds to "merchandise being provided by an entity other than an entity that is providing the motion video presentation" wherein the advertised soft-drink Coke™ is not provided by the broadcast provider.

Claims 99 and 112 are rejected wherein the "at least one processor . . . enables trick-mode functionality to be implemented in connection with said one of the plurality of motion video presentations" (Figure 5).

Claims 100, 102, 113, and 115 are rejected wherein the White et al. reference discloses that the "merchandise advertising data" [70] associated with HTML primitives delivered via the network [16] is modulated "received over a first communication channel" and the "motion video presentation" is "received over a second communication channel that is

different from said first communication channel" such that each is associated with a different "radio-frequency channel having a specified center frequency" in the case of digital video distribution (Col 2, Lines 37-46, 49-52).

Claims 101 and 114 are rejected wherein the "first and second communication channels correspond to a same type of communication channel" wherein both channels are of a type that distributes video information to the subscriber.

In consideration of claim 103, the White et al. reference discloses that the aforementioned "first and second communication channels" are modulated [34] (Col 2, Lines 37-46), however, the reference does not explicitly disclose the particular type of digital modulation utilized in conjunction with the distribution of the "merchandise advertising data". The examiner takes OFFICIAL NOTICE that the particular usage of a "first and second communication channel" wherein "said first communication channel utilizes a quadrature phase shift keying (QPSK) and the second communication utilizes a quadrature amplitude modulation (QAM) is notoriously well known in the art of video distribution. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize both QAM and QPSK channels for purpose of facilitate the delivery of "merchandising data" given the inherent advantages associated with each including the capability of being able to send and receive merchandising data though both in-band and out-of-band tuning.

10. Claims 104 and 117 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (US Pat No. 6,628,302), in view of Wang (US Pat No. 6,675,385).

The White et al. reference does not explicitly disclose nor preclude the particular distribution of the "merchandise advertising data" associated with the HTML based user interface via the "broadcast file system" [30] in a "cyclical" manner. The Wang reference discloses a method for distributing an HTML interface using a carousel or "cyclically" (Col 2, Lines 9-50). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the "cyclical" interface distribution techniques of Wang in conjunction with the White et al. embodiment for the purpose of enabling the distribution and display of a HTML based user interface to resource-deprived set-top boxes (Wang: Col 2, Lines 50-59).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
November 24, 2004

JOHN MILLER
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